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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,334	07/01/2004	David S. Bonalle	70655.3100	4333
20322	7590	01/27/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TB

Office Action Summary	Application No. 10/710,334	Applicant(s) BONALLE ET AL.	
	Examiner Daniel I Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 1 July 2004 and 5 August 2004.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 8, 10, and 19 of copending Application No. 10/708,822, claims 5 and 12 of copending Application No. 10/708,827, claim 38 of copending Application No. 10/708,835, claims 1-11 of copending Application No. 10/708,840, claim 3 of copending Application No. 10/708,824, claim 5 of copending Application No. 10/708,826, claim 2 of copending Application No. 10/708,823, claims 5, 24, and 38 of copending Application No. 10/708,825, claims 5, 24, and 37 of copending Application No. 10/708,834, claims 5, 24, and 37 of copending Application No. 10/708,831, claim 2 of copending Application No. 10/708,838, claims 5, 27, 38, and 41 of copending Application No. 10/708,836, claims 3, 5, and 12 of copending Application No.

10/708,839, claims 5, 28, and 38 of copending Application No. 10/708,833, and claims 5, 24, and 30 of copending Application No. 10/708,828. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the copending applications and the currently pending application are obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haala (US 2005/0005172).

Re claim 1, Haala teaches detecting proffered biometric at a sensor to obtain a proffered biometric sample; storing the proffered biometric sample on a database such that the system utilizes the proffered biometric sample to authorize a smart card transaction (FIG. 2 and paragraph [0035]+). Re claim 2, it is obvious that Haala teaches that detection includes at least one of detecting, associating and processing a proffered biometric sample, at least through the collection of biometric information (48). Re claim 3, as the biometric samples are digitized and stored at a central location (server/database) it is interpreted as logging samples, especially since more than one biometric can be sampled. Re claim 4, Haala teaches detecting one additional proffered biometric sample (paragraph [0042]+). Re claim 5, it has been discussed above that the verification of the sample includes at least one of processing, comparing, and verifying the biometric sample.

Re claims 1 and 5, Haala is silent to a smart card, and verifying the proffered biometric sample. The Examiner notes that although Haala is silent to a smart card, it would have been well within the skill in the art to use a smart card, in order to accommodate increased security and storage demands, as is well known in the art. The Examiner notes that the biometric information is digitized (50), which is broadly interpreted as verifying the proffered biometric sample by at least one of processing, comparing, and verifying the biometric sample. The Examiner also notes that such verification is well known and conventional in the art, in order to have the biometric data ready and in a form that is appropriate for comparison to authorize a transaction (see Fujii et al. (US 6,233,348) which teaches verifying the proffered biometric sample by at least one of processing, comparing, and verifying the biometric sample (FIG. 12)).

Re claim 9, it is discussed re claim 5 that verifying includes at least one of processing, comparing, and verifying the biometric sample. Accordingly, it is obvious that at least digitizing of a proffered biometric sample includes using at least one of a local CPU and a third party vendor (see FIG. 1).

Re claim 10, Haala teaches that additional security procedures can be used to verifying the identity of a person (paragraph [0042]), which is interpreted as a secondary security procedure (social security number, hair color, height, etc.) to add additional levels of security.

Re claim 11, Haala teaches storing the biometric sample includes storing a proffered biometric sample on at least one of a local database, a remote database, and a third party controlled database (FIG. 2), which is interpreted to include a database.

4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halla, as discussed above, further in view of Robinson (US 2003/0061172).

The teachings of Halla have been discussed above.

Re claims 6-8, the Halla is silent to comparing the proffered biometric sample with a stored biometric sample (of at least one of a criminal, a terrorist, and a cardmember) and that the verifying is done using information contained on at least one of a local database, a remote database, and a third party controlled database.

Robinson teaches a system for biometric authorization for transaction processes. Specifically, Robinson teaches that during the enrollment process, customer data (interpreted as including biometric data) is compared to data already registered in the central database for uniqueness (paragraph [0057]). Accordingly, this is interpreted as comparing a proffered biometric sample with a stored biometric sample. The Examiner notes that the biometric sample

can be one of a criminal, terrorist, or cardmember, since the comparison is performed to reduce multiple enrollments or reduce/alert fraudulent enrollments (paragraph [0057]).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Halla with those of Robinson.

One would have been motivated to do this in order to increase the security of the card transaction system by the verification means.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Stevens (US 2004/0014457), Nakamura et al. (US 2003/0046540), Ando et al. (US 2004/0172541), Doi (US 2004/0062423), Robinson (US 2003/0177102), Simon (US 2003/0086591), Hofi (US 2003/0074317), ShamRao (US 2004/0059923), Bogosian, Jr. (US 2004/0059923 and RE36,580), Barillova et al. (US 2004/0199469), Lee (US 2004/0195314), Hoffman et al. (US 2004/0020982), Garrity (US 2004/0215575), Hoehn-Saric et al. (US 5,915,973), Hillhouse et al. (US 2003/0223625), Yamaguchi et al. (US 2001/0036301), Fujii et al. (US 6,233,348), Flink (US 2004/0098336), Meadows et al. (US 5,869,822), Piosenka et al. (US 4,993,068), Lewis (US 2002/0178124), Maritzen (US 2002/0191816), and Kim (US 2002/0087869).

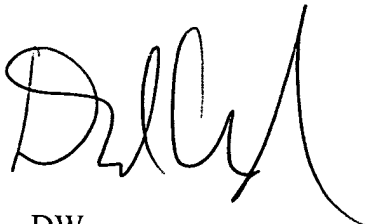
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
1/12/05



KARL D. FRECH
PRIMARY EXAMINER